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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/780,222 | 02/09/2001 | Andrew M. Schwarzbauer | 38916/24384 | 5359 |

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THOMPSON COBURN, LLP
ONE FIRSTAR PLAZA
SUITE 3500
ST LOUIS, MO 63101

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| EXAMINER | |
| HENDERSON, MARK T | |
| ART UNIT | PAPER NUMBER |

3722

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/780,222 | SCHWARZBAUER ET AL. | |
| | Examiner | Art Unit | |
| | Mark T Henderson | 3722 | |

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 6 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 16-23 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 February 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, are drawn to a form, classified in class 283, subclass 62.
 - II. Claims 16-23, are drawn to a method of making a form, classified in class 83, subclass 701.

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2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as separating by perforating.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Attorney Robert Haldiman on June 2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 16-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “primary film layer bonded directly to the base layer” as stated in claim 9; and “a breakaway layer applied in a pattern such that an area furthest the periphery receives a coating (or polymer) having a greater affinity for the primary film layer and an area adjacent the periphery receives a coating (or polymer) having less affinity for the primary layer” as stated in Claims 10 and 11; must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 1 recites the limitations: "the top layer" line 6; "the bottom surface" in line 7 and 15; and "the form layer" in line 9. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 2 recites the limitation "the form layer" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

10. Claim 1, 3-7, 8 and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 6, 8 and 9 of U.S. Patent No. 6352,287 (Casagrande). Although the conflicting claims are not identical, they are not patentably distinct from each other because Casagrande discloses in the claims the limitations of a form having a base paper layer (paper layer) having top and bottom surfaces; a primary film layer (transparent lamina) a breakaway layer (release agent layer) coated on top of the primary layer (transparent lamina); an adhesive layer; die cuts extending through the top and bottom surfaces of a business form layer (paper layer), adhesive layer and through the breakaway layer; wherein the breakaway layer has a greater affinity for the adhesive layer than the primary film layer; wherein

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the bottom surface of the release layer and top and bottom surfaces of the base paper layer are capable of accepting print; and wherein the breakaway layer is composed of translucent material, and made of acrylic urethane, and varies in thickness (between 0.1 and 1 mil).

However, Casagrande does not disclose: a breakaway layer having release levels that vary in a predetermined pattern; a lower release level adjacent the periphery of the primary film layer; and composed of a material having a thickness that varies at different points along the primary film layer.

In regards to **Claims 1 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the various release levels of the breakaway layer at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the breakaway layer of any desirable material that varies in thickness at different points, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 8**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the die-cuts at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-9 and 15, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (6,328,340).

Fischer discloses in Fig. 2a, a form with an integrated card comprising: a primary film (21) having top and bottom surfaces and a periphery; a breakaway layer (22) directly and removably bonded to the primary film layer, constructed of translucent urethane acrylic, and capable of accepting printed indicia (Col. 5, lines 20-25); a secondary film layer (23) adhesively bonded to the breakaway layer; a die-cuts (31); and a base paper layer (1) adhesively bonded (adhesive 24) to the secondary film layer.

However, Fischer does not disclose: composed of a material having a thickness that varies at different points along the primary film layer; a breakaway layer having release levels that vary in a predetermined pattern; a lower release level adjacent the periphery of the primary film layer; .

In regards to **Claims 1 and 7**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the various release levels of the breakaway

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layer at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the breakaway layer of any desirable material that varies in thickness at different points, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 8**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the die-cuts at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Allowable Subject Matter

12. Claims 10-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Fischer (95/20493), Roth et al ('078), Roth et al ('018), Casagrande ('497), Casagrande ('051), Casagrande ('655), Steidinger et al, Fischer ('747), Fischer ('212), and Fischer ('574) disclose a form with an integrated card.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

June 23, 2002



A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700